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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,395	05/18/2001	Remi de Montgolfier	Q64527	3179
23373	7590	04/07/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			PERSINO, RAYMOND B	
			ART UNIT	PAPER NUMBER
			2682	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/859,395

Applicant(s)

MONTGOLFIER

Examiner

Raymond B. Persino

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by  
anticipated by MULLER (US 6,845,238 B1)

Regarding claim 1, MULLER discloses a method of signaling compressed mode parameters to a mobile station from a mobile radiocommunications network, the method comprising transmitting, from said network to said mobile station, a signaling message containing said compressed mode parameters together with measurement control parameters for radio measurements to be performed by said mobile station (column 18 lines 37-56, column 19 lines 20-43, column 23 lines 1-21 and column 24 lines 33-41).

Regarding claim 2, see the rejection of the parent claim concerning the subject matter this claim depends from. MULLER further discloses that the measurement control parameters indicate whether a type of radio measurements to be performed are intra-frequency, inter-frequency, or inter-system type measurements (column 22 line 55 to column 23 line 21).

Regarding claim 3, MULLER discloses a base station for transmitting to a mobile station a signaling message containing compressed mode parameters and measurement control parameters for radio measurements to be performed by the mobile station (column 18 lines 37-56, column 19 lines 20-43, column 23 lines 1-21 and column 24 lines 33-41).

Regarding claim 4, see the rejection of the parent claim concerning the subject matter this claim depends from. MULLER further discloses that measurement control parameters indicate whether a type of radio measurements to be performed are intra-frequency, inter-frequency, or inter-system type measurements (column 22 line 55 to column 23 line 21).

Regarding claim 5, MULLER discloses a mobile station configured to receive compressed mode parameters in a signaling message which is transmitted thereto by a mobile radiocommunications network, the signaling message containing measurements control parameters for radio measurements to be performed by the mobile station (column 18 lines 37-56, column 19 lines 20-43, column 23 lines 1-21 and column 24 lines 33-41).

Regarding claim 6, see the rejection of the parent claim concerning the subject matter this claim depends from. MULLER further discloses that measurement control parameters indicate whether a type of radio measurements to be performed are intra-frequency, inter-frequency, or inter-system type measurements (column 22 line 55 to column 23 line 21).

Regarding claim 7, see the rejection of the parent claim concerning the subject matter this claim depends from. MULLER further discloses that the signaling message is a measurement control message (column 18 lines 37-56, column 19 lines 20-43, column 23 lines 1-21 and column 24 lines 33-41).

Regarding claim 8, see the rejection of the parent claim concerning the subject matter this claim depends from. MULLER further discloses that the signaling message is a measurement control message (column 18 lines 37-56, column 19 lines 20-43, column 23 lines 1-21 and column 24 lines 33-41).

Regarding claim 9, see the rejection of the parent claim concerning the subject matter this claim depends from. MULLER further discloses that the signaling message is a measurement control message (column 18 lines 37-56, column 19 lines 20-43, column 23 lines 1-21 and column 24 lines 33-41).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond B. Persino whose telephone number is (571) 272-7856. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian C. Chin can be reached on (571) 272-7848. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Raymond B. Persino

Examiner

Art Unit 2682

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**VIVIAN CHIN**  
SUPERVISORY PATENT EXAMINER  
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